



**UNITED STATES DEPARTMENT OF COMMERCE  
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/580,400	05/26/00	ASDOORIAN	A 9197.01

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HM22/0130

EXAMINER

MCCORMICK, S

ART UNIT	PAPER NUMBER
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1661

DATE MAILED:

01/30/01

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.

09/580,400

Applicant(s)

ASDOORIAN ET AL.

Examiner

Susan B. McCormick

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.
- 18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: \_\_\_\_\_.

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### **Detailed Action**

#### **Drawings**

The drawings have been approved by an official draftsman.

#### **Title**

The following title is suggested: --Peach tree named 'Island Prince'.--

#### **Abstract**

The abstract of the disclosure does not commence on a separate sheet in accordance with 37 CFR 1.52(b)(1). A new abstract of the disclosure is required and must be presented on a separate sheet, apart from any other text.

#### **Claim**

The claim in this application does not commence on a separate sheet in accordance with 37 CFR 1.52(b). Appropriate correction is required in response to this action.

#### **Objection to the Disclosure**

##### **37 CFR 1.163**

The following is a quotation of section (a) of 37 CFR 1.163:

(a) The specification must contain as full and complete a disclosure as possible of the plant and the characteristics thereof that distinguish the same over related known varieties, and its antecedents, and must particularly point out where and in what manner the variety of plant has been asexually reproduced. In the case of a newly found plant, the specification must particularly point out the location and character of the area where the plant was discovered.

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35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

As specific to United States Plant Patent applications, the specifics of 37 CFR 1.164 (reproduced below) are controlling:

The claim shall be in formal terms to the new and distinct variety of the specified plant as described and illustrated, and may also recite the principal distinguishing characteristics. More than one claim is not permitted.

In plant applications filed under 35 U.S.C. 161, the requirements of 35 U.S.C. are limited. The following is a quotation of 35 U.S.C. 162:

No plant patent shall be declared invalid for noncompliance with section 112 of this title if the description is as complete as is reasonably possible. The claim in the specification shall be in formal terms to the plant shown and described.

The disclosure is objected to under 37 CFR 1.163 (a) and under 35 U.S.C. 112, first paragraph, because the specification presents less than a full, clear and complete botanical description of the plant and the characteristics which define same per se and which distinguish the plant from related known cultivars and antecedents.

More specifically:

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A. The spacing of the lines of the specification is such as to make reading and entry of amendments difficult. New application papers with lines double spaced on good quality paper are required. See 37 CFR 1.52.

B. Applicant should refer to cultivar names within single quotation marks, as this is the convention employed by the International Code of Botanical Nomenclature.

C. The color reference that is used by the Applicant, "Dictionary of Color by Maerz & Paul, First Edition 1930," is unavailable to the Examiner. However, Applicant should be advised the USPTO has on hand the 1950 edition of same.

D. Applicant should set forth in the specification the age of the observed plant.

E. On page 2, line 18, Applicant states "In the center the fruit showing the stem end,...". It appears that in the photographic illustration the center is actually referring to the distal end, not the stem end. Correction is needed.

F. On page 2, line 31, a -- is needed at the end of the sentence. Correction is needed.

G. On page 2, line 35, --United States-- should be inserted after 'Island King' to clarify that it is an United States patent. Clarification is needed.

H. Additional quantitative information should be imported into the specification relative to characteristic and observed height and spread for the observed plant at a specified age and location of culture, and/or amount of growth over a specified period of time.

I. On page 2, line 41, it states "Productivity is very good for four year old tree." This conflicts with page 1, line 33, as it states "...first asexually reproduced by the inventor in 1997...." It is not currently a four-year old tree. This also conflicts with line 38, page 2 which states "Moderate at 4<sup>th</sup> year of growth." Clarification is required.

J. On page 2, line 42, Applicant should explain the term "regular" as it pertains to the "regularity of bearing." Clarification is needed.

K. Applicant should set forth the in the specification the productivity of the fruit i.e. pounds per bushels per acre and the storability of the fruit in the interest of providing as complete a botanical description as is reasonably possible.

L. On page 3, line 3, it appears the term "Lentils" is misspelled. Applicant could mean --Lenticels--. Correction is needed.

M. Applicant should set forth in the specification the color of the lenticels in the interest of providing as complete a botanical description of the observed plant as is reasonably possible.

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Applicant should also disclose the average number of lenticels, as “many” (page 3, line 3) is vague and insufficient. Correction is needed.

N. On page 3, line 3, Applicant should clarify the measurement “(.16-28 inch).” Applicant could possibly mean --(.16-.28 inch)--. Clarification is needed.

O. Applicant should be consistent throughout the specification with regard to the color descriptions that range from “Page 52, Plate 15C6, Grey 31” (page 3, line 3) to “maroon 7H4” (page 4, line 30). Clarification is needed.

P. If possible, Applicant should set forth a more detailed botanical description relative to branch size i.e. diameter, length and typical crotch angles of same.

Q. On page 3, line 7, it is unclear as to what Applicant is meaning by “Sl.” Clarification is needed.

R. Applicant should disclose the texture and base shape of the observed leaf.

S. On page 3, lines 24-25, the terms “Upwardly disposed surface” and “Downwardly disposed surface” are unclear. This could mean the apex and base of the **upper** surface colors or the upper **and** lower surface colors which Applicant should disclose both surface colors. Clarification is needed.

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T. On page 3, line 24, Applicant states the color of the upwardly disposed surface as being "Pg. 68, Pl. 23 J3- Mt. Vernon Green." It appears that J8 is actually Mt. Vernon Green and not J3. Clarification is needed.

U. In the interest of providing as complete a botanical description of the observed plant as is reasonably possible Applicant should disclose the venation pattern of the leaf as well as the leaf arrangement.

V. On page 3, lines 28, 35, Applicant should delete the parenthesis around the color or insert parenthesis around all the colors mentioned to make the specification consistent throughout. Clarification is needed.

W. Applicant should set forth in the specification the color, size, location and the number of glands in the interest of providing as complete a botanical description of the observed plant as is reasonably possible. The term "medium" is vague and insufficient. Correction is needed.

X. Applicant should provide useful information regarding the petiole by utilizing appropriate descriptive terms such as --Diameter--. The recitation "Thickness" is vague and insufficient.

Y. On page 3, line 35, it appears that the color reference is missing a number i.e. "Pl. 20K -." Clarification is needed.



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✓ Z. In the interest of providing as complete a botanical description of the observed plant as is reasonably possible Applicant should disclose the length and diameter of the bud.

AA. On page 4, line 7, the “color 6C9 Medium brownish-gray” conflicts with the Dictionary of Color Maerz & Paul which states 6C9 is --Rosestone--. Clarification is needed.

AB. Applicant should delete the space on page 4, line 10, that is between “date” and “of.” Correction is needed.

AC. On page 4, line 12, the measurement “.32mm” appears to be misspelled. Applicant could mean --32mm-- as the current measurement is unrealistic as to the diameter of the bloom. Correction is needed.

AD. Applicant has not stated whether or not the observed plant’s flower has a characteristic fragrance. If the plant’s flower does have a fragrance then Applicant is solicited to describe the fragrance. If the plant’s flower does not have a fragrance then Applicant should disclose a statement such as --No fragrance--.

✓ AE. Applicant should set forth in the specification the shape of the apex and base and number of petals of the observed plant.

AF. Applicant should set forth in the specification the size and number of sepals.

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AG. Applicant should set forth in the specification the number of stamens and pistils.

AH. On page 4, line 24, the recitation "(2-3 mm)" should read --2-3 mm-- and ".079 inch- .12 inch." Should read --(.079 inch - .12 inch)--. Correction is needed.

AI. Applicant should set forth in the specification the diameter of the pedicel of the observed plant.

AJ. On page 4, line 26, the term "glabrous" appears to be misspelled. Applicant could mean --glabrous--. Correction is needed.

AK. Applicant should disclose the length, width and number of sepals in the interest of providing as complete a botanical description of the observed plant as is reasonably possible.

AL. Applicant should disclose the length of the anther as the term "average" (page 4, line 35) is vague and insufficient in this regard. Correction is needed.

AM. On page 4, line 44, Applicant states that "19D2" is seafoam green whereas Maerz & Paul have listed 19D2 as Reed green. Clarification is needed.

AN. On page 5, line 12, Applicant should disclose the color reference number with the color "yellow." Correction is needed.

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AO. In the interest of providing as complete a botanical description of the observed plant as is reasonably possible Applicant should disclose the length, diameter and color of the stem of the observed plant.

AP. On page 5, lines 23, 25, and page 6, lines 3, 11, it is unclear as to what Applicant is meaning by "Sl." Clarification is needed.

AQ. In the interest of providing as complete a botanical description of the observed plant as is reasonably possible, characteristic and observed fruit weight should be imported into the specification.

AR. On page 6, line 7, Applicant should provide useful information regarding the stone thickness by utilizing appropriate descriptive terms such as --Diameter--. The recitation "Thickness" is vague and insufficient. Correction is needed.

AS. On page 6, line 10, the recitation "Color Code Dry" is vague and unclear as to what the Applicant is referring. Clarification is needed.

AT. Applicant should set forth in the specification the texture of the stone of the observed plant.

AU. On page 6, line 22, the term "etal" should be --et al--. Correction is needed.

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AV. Applicants should positively quantify known shipping and storage characteristics of the observed variety, such as for example, the number of days the fruit has been stored under specific conditions.

AW. Information relative to pollination requirements of the instant tree should be included in the specification, if available.

AX. If additional information is available relative to plant/fruit disease resistance/susceptibility, such should be set forth in the specification.

AY. Applicant should disclose information to the observed plant's winter hardiness and drought/heat tolerance.

The above listing may not be complete. Applicant should carefully review the disclosure and import into same any corrected or additional information which would aid in botanically identifying and/or distinguishing the cultivar for which United States Plant Patent protection is sought.

#### Claim Rejection

35 U.S.C. § 112, 1st and 2nd Paragraphs

Claim 1 is rejected under 35 U.S.C. 112, first and second paragraphs as not being supported by a clear and complete botanical description of the plant for reasons set forth in the

Objection to the Disclosure Section above, and under 35 U.S.C. 112 first paragraph for the reasons advanced in the objection to the oath/declaration and objection to the drawings.

Comments

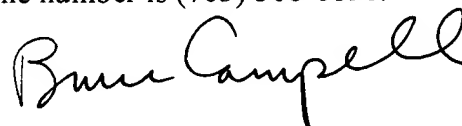
Due to the amount of revision seen necessary in this application, it is suggested that Applicant file a substitute specification, incorporating all additions, deletions and modifications so as to provide the printer a clean copy at the time of allowance. Applicant should specifically authorize cancellation of the present specification to the same.

Future Correspondence

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Susan B. McCormick whose telephone number is (703) 305-1682. The Examiner can normally be reached Monday through Thursday from 7:00 a.m. to 4:30 p.m. and alternate Fridays from 7:00 a.m. to 3:30 p.m.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Bruce Campell, can be reached on (703) 308-4205. The fax number for the group is (703) 305-3041 or 308-4242.

Any inquiry of a general nature or relating to the status of this application should be directed to the Matrix Customer Service Center whose telephone number is (703) 308-0196.



sbm

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